

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Alejandro Wiechers

Group Art Unit: 2625

Serial No.: 10/635,437

Examiner: Singh, Satwant

Filed: August 7, 2003

Docket No. 200207446-1

For: **Method of Performing Automated Packaging and Managing Workflow In a Commercial Printing Environment**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed February 26, 2008, responding to the Final Office Action mailed October 31, 2007.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 9-17 have been canceled leaving claims 1-8 and 18-23 remaining. Each of those claims stand finally rejected. No claims have been allowed. The final rejections of claims 1-8 and 18-23 are appealed.

IV. Status of Amendments

This application was originally filed on August 7, 2003, with seventeen (17) claims. In a Response filed July 31, 2007, Applicant amended claims 1-8, canceled claims 9-17, and added new claims 18-23.

All of the above-identified amendments have been entered and no other amendments have been made to any of claims 1-8 and 18-23. The claims in the attached Claims Appendix (see below) reflect the present state of those claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 1 describes a method of performing automated packaging on a printed output in a commercial printing environment that includes a designer location and a print service provider location. The method comprises creating at the designer location a digital file that represents an image to be printed. *Applicant's specification*, pages 6-7, paragraph 0020; Figure 1, item 100. The method of claim 1 further comprises receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location. *Applicant's specification*, pages 8-9, paragraphs 0025-0027; Figure 1, item 106. The method of claim 1 further comprises generating at the designer location packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information. *Applicant's specification*, page 7, paragraph 0022; Figure 1, item 104; Figure 2, item 210. The method of claim 1 further comprises creating at the designer location a high performance file that contains the digital file and

the packaging instructions. *Applicant's specification*, page 12, paragraph 0041; Figure 1, item 118. The method of claim 1 further comprises submitting the high performance file from the designer location to the print service provider location via an electronic network. *Applicant's specification*, page 12, paragraph 0043; Figure 1, item 120. The method of claim 1 further comprises generating at the print service provider location a printed output of the digital file and packaging the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file. *Applicant's specification*, pages 17-18, paragraphs 0061-0062 and 0067-0068; Figure 1, items 138 and 142.

Independent claim 18 describes a system for performing automated packaging on a printed output. The system comprises a designer location configured to create a digital file that represents an image to be printed. *Applicant's specification*, pages 6-7, paragraph 0020; Figure 1, item 100. The designer location is further configured to receive from a print service provider location real time configuration information regarding a print production device at the print service provider location. *Applicant's specification*, pages 8-9, paragraphs 0025-0027; Figure 1, item 106. The designer location is further configured to generate packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information. *Applicant's specification*, page 7, paragraph 0022; Figure 1, item 104; Figure 2, item 210. The designer location is further configured to create a high performance file that contains the digital file and the packaging instructions. *Applicant's specification*, page 12, paragraph 0041; Figure 1, item 118. The designer location is further configured to submit the high

performance file to the print service provider location via an electronic network. *Applicant's specification*, page 12, paragraph 0043; Figure 1, item 120. The system of claim 18 further comprises a print service provider location configured to generate a printed output of the digital file and package the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file. *Applicant's specification*, pages 17-18, paragraphs 0061-0062 and 0067-0068; Figure 1, items 138 and 142.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed on appeal:

1. Claims 1-8 and 18-23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Hansen, et al.* ("Hansen," U.S. Pat. No. 6,407,820).

VII. Arguments

The Appellant respectfully submits that Applicant's claims are not anticipated under 35 U.S.C. § 102, and respectfully requests that the Board of Patent Appeals reverse the final rejections of those claims at least for the reasons discussed below.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-8 and 18-23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Hansen, et al.* ("Hansen," U.S. Pat. No. 6,407,820). Applicant respectfully traverses.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Hansen reference. Applicant discusses the Hansen reference and Applicant's claims in the following.

A. The Hansen Disclosure

Hansen discloses a system and method for managing production printing workflow. As described by Hansen, the system comprises a computer network 112, such as a LAN that is located at a print shop. *Hansen*, column 3, lines 52-65.

Production workflow using the system is described to comprise five main stages: job origination 102, job submission 104, job preparation 106, print production 108, and final fulfillment 104. See *Hansen*, Figure 1. In job origination 102, documents and instructions are received from a customer as a “job.” *Hansen*, column 4, lines 4-6. In job submission 104, the job is entered into the print shop’s production system or workflow. *Hansen*, column 4, lines 22-24. In job preparation 106, the documents of the job are prepared for printing at the print shop according to the customer instructions. *Hansen*, column 5, lines 18-19. In print production, a final forms of the documents are sent to a print server 120 that will distribute the documents to a final output device 122. *Hansen*, column 7, lines 25-29. Finally, in final fulfillment 110, the finished output is produced on the final output device 122 (e.g., printer). *Hansen*, column 8, lines 7-10.

B. Applicant’s Claims

As is noted above, Hansen fails to teach several of Applicant’s claim limitations. Applicant discusses some of those claim limitations in the following.

1. Claims 1-8

Applicant's independent claim 1 provides as follows:

1. A method of performing automated packaging on a printed output in a commercial printing environment that includes a designer location and a print service provider location, said method comprising:

creating at the designer location a digital file that represents an image to be printed;

receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location;

generating at the designer location packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information;

creating at the designer location a high performance file that contains the digital file and the packaging instructions;

submitting the high performance file from the designer location to the print service provider location via an electronic network; and

generating at the print service provider location a printed output of the digital file and packaging the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file.

(a) The Actions Described by Hansen Occur at a "Print Shop," Not at a "Designer Location"

As a first matter regarding claim 1, Applicant notes that Hansen does not disclose any "designer location". Instead, as described above, Hansen only discloses a "print shop." As described by Hansen, "FIG. 1 further depicts a typical computer network 112 for

use in a print shop.” *Hansen*, column 3, lines 51-52. In Figure 1, the reference numeral 112 is applied to the entire extent of the “PRINT SHOP.” See *Hansen*, Figure 1.

Regarding Hansen’s disclosed “job preparation 106” identified and relied upon in the final Office Action, job preparation is an action, not a location, and Hansen explicitly states that the action is performed at the print shop, not a location of the designer that created the document to be printed. For example, Hansen states that the job preparation 106 is performed on the job preparation stations 116 and the network servers 118 coupled with the store front workstation 114. *Hansen*, column 6, lines 16-19. Applicant notes that each of the store front workstations 114, job preparation stations 116, and the network servers 118 are part of the print shop’s network. See *Hansen*, Figure 1. Furthermore, in relation to job preparation 106, Hansen states that the customer may “bring in” to the print shop documents to be used to create a job at the print shop. *Hansen*, column 5, lines 30-32. Moreover, Hansen’s discussion of the job preparation stage includes multiple references to “operators” performing the job preparation at the print shop (*Hansen*, column 5, line 18 to column 7, line 24) and descriptions of how the print shop can “add value” by performing various actions at the print shop during job preparation (*Hansen*, column 6, line 51 to column 7, line 24).

In view of the above, it is clear that *all* of the actions that fall under Hansen’s “job preparation 106” occur at the print shop. In other words, those actions occur at a print service provider location, not a designer location.

In the Advisory Action the Examiner’s stated that “[t]he examiner is interpreting the job preparation workstations 116, which are located in the print shop as being the designer location.” The Examiner’s interpretation is clearly unreasonable given that the Examiner

explicitly admits that the job preparation workstations 116 are “located in the print shop.” Applicant respectfully submits that the admission proves Applicant’s point that the various actions disclosed by Hansen do not occur at a designer location. Specifically, because the job preparation workstation 116 is located at the print shop, it cannot instead be located at the designer’s location. Moreover, the only way the job preparation workstation 116 could be interpreted as being at both locations at the same time is if the print shop were owned or operated by the designer of the job to be printed. Hansen, however, provides no such disclosure.

As a final matter, Applicant notes that the print shop or its operators cannot properly be interpreted as the “designer” of the document to be printed. As is clear from Applicant’s disclosure, the term “designer” is used to denote the person or organization that creates the documents and then provides them to a print service provider location (e.g., print shop) for printing. *See, e.g., Applicant’s specification*, paragraphs 0001 and 0009. Applicant notes that it is well established in the law that claim terms are to be *interpreted in light of the specification*. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff’d*, 517 U.S. 370, 38 USPQ2d 1461 (1996) (“Claims must be read in view of the specification, of which they are a part”).

(b) No Teaching of Creating a File “at the Designer Location”

As a second matter, Hansen does not teach “creating at the designer location a digital file that represents an image to be printed”. Again, Hansen does not describe actions that occur at any “designer location” and instead limits his disclosure to attributes

of a print shop. It logically follows then that Hansen does not teach creating a digital file “at the designer location” as required by claim 1.

Applicant further notes that the Examiner’s comments in the Advisory Action relate to actions disclosed by Hansen that occur at the print shop and not a designer location, as required by claim 1.

(c) No Teaching of Receiving at a Designer Location “Real Time Configuration Information Regarding a Print Production Device”

Third, Hansen does not teach “receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location”. As stated above, Hansen does not describe actions that occur at any “designer location” and instead limits his disclosure to attributes of a print shop. It logically follows then that Hansen does not teach receiving real time configuration information regarding a print production device “at the designer location” as required by claim 1.

Applicant further notes that, even if one were to improperly interpret Hansen’s print shop as incorporating a “designer location” (e.g., in the form of a job preparation station 116), Hansen *still* fails to teach such a location receiving “real time configuration information regarding a print production device at the print service provider location”. Applicant notes that column 6, lines 16-50 of the Hansen reference, which were cited by the Examiner in the final Office Action in addressing the “real time configuration information” limitation, do not say anything about “real time configuration information” whether it be about a “print production device” or other component of Hansen’s system.

Regarding column 7, lines 42-46 and column 7, line 63 to column 8, line 6, which were identified by the Examiner in the Advisory Action, Applicant notes that those portions of Hansen's disclosure are similarly deficient. Specifically, a disclosure of a print server being "coupled to" output devices is not a teaching of receiving "real time configuration information", and neither is a general reference to job attributes and load balancing. The Examiner's conclusion that information is passed in Hansen's system in real time is not based not on a teaching contained within the reference but on mere supposition and speculation. For a proper case under 35 U.S.C. § 102, the applied reference must explicitly teach and/or inherently require each and every limitation. Real time communication of information is neither taught by Hansen nor inherently required by Hansen's system.

**(d) No Teaching of Generating at a Designer Location
“Packaging Instructions that Describe how the Printed
Output is to be Packaged for Shipment”**

Fourth, Hansen does not teach “generating at the designer location packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information”. Again, Hansen does not describe actions that occur at any “designer location” and instead limits his disclosure to attributes of a print shop. It logically follows then that Hansen does not teach generating packaging instructions “at the designer location” as required by claim 1. Moreover, even if one were to interpret Hansen’s print shop as incorporating a “designer location” (e.g., in the form of a job preparation station 116), Hansen *still* fails to teach such a location generating packaging instructions “that describe how the printed output is to be packaged for shipment after printing”. Indeed, Hansen does not even discuss packaging documents for shipment at all. The only “packages” Hansen speaks of are *software* packages. Regarding the Examiner’s citation in the final Office Action of column 9, lines 23-30 of the Hansen reference, that portion of the Hansen reference says nothing whatsoever about such “packing instructions”. In response to the Examiner’s statement that “tickets are visually represented to the workstation 116 display,” visual representation of tickets does *not* inherently require visual representation of “packaging instructions”. Given that Hansen does not describe generating packaging instructions that describe how printed output is to be packaged for shipment after printing, it follows that Hansen likewise fails to teach generating those instructions “relative to the received configuration information”.

Regarding the Examiner's statement in the Advisory Action that "[t]he finishing of the document is being interpreted by the examiner as being packaging of the document," the Examiner is again drawing an unwarranted conclusion. Both the term "finishing" and the term "packaging" are well known in the printing arts. "Finishing" pertains to the various actions that are taken to finalize a printed document. Such actions may, for example, comprising stapling or binding. Indeed, Hansen explicitly identifies both stapling and binding as two example finishing actions in the except identified by the Examiner in the Advisory Action. See *Hansen*, column 8, lines 12-15. In contrast, "packaging" comprises the action of packing finished documents for shipment. Indeed, Applicant's claim 1 explicitly recites packaging "for shipment". There is simply no basis, either in the Hansen reference or the knowledge of persons having ordinary skill in the printing arts, to support the Examiner's interpretation that Hansen's document finishing actually means packaging for shipment.

Applicant further submits that packaging for shipment cannot be properly interpreted to comprise document finishing. Applicant's own disclosure, which must be consulted when interpreting the claim terms, *separately describes* both document finishing (*Applicant's specification*, paragraphs 0064-0066) and packaging for shipment (*Applicant's specification*, paragraph 0067-0068).

**(e) No Teaching of Creating at a Designer Location a File that
“Contains the Digital File and the Packaging Instructions”**

Fifth, Hansen does not teach “creating at the designer location a high performance file that contains the digital file and the packaging instructions”. Again, Hansen does not describe actions that occur at any “designer location” and instead limits his disclosure to attributes of a print shop. It logically follows then that Hansen does not teach creating a high performance file “at the designer location” as required by claim 1. Moreover, Applicant notes that Hansen fails to teach creating a high performance file that contains a digital file and “packaging instructions”. Again, Hansen is silent as packaging for shipment. It logically follows then that Hansen does not teach creating a file that contains packaging instructions.

Regarding the Examiner’s argument in the Advisory Action that an “electronic job ticket” is created in Hansen’s system, the ticket is created at the print shop not a designer location, and creation of a job ticket does not inherently require the creation of shipment packaging instructions.

**(f) No Teaching of “Packaging the Printed Output”
According to “Packaging Instructions”**

Sixth, Hansen does not teach “packaging the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file”. As stated repeated above, Hansen says nothing of “packaging” a printed output, or anything else for that matter. It logically follows then that Hansen does

not teach “packaging the printed output . . . in accordance with the packaging instructions contained within the high performance file”.

(g) Conclusion as to Claims 1 and 2-8

In view of the foregoing, it is clear that Hansen does not anticipate claim 1 or claims 2-8 which depend therefrom. Applicant therefore respectfully submits that the rejections of claims 1-8 should be reversed.

2. Claims 18-23

Applicant's independent claim 18 provides as follows:

18. A system for performing automated packaging on a printed output, said system comprising:

a designer location configured to:

create a digital file that represents an image to be printed,
receive from a print service provider location real time configuration information regarding a print production device at the print service provider location,
generate packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information,
create a high performance file that contains the digital file and the packaging instructions, and
submit the high performance file to the print service provider location via an electronic network; and

a print service provider location configured to generate a printed output of the digital file and package the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file.

As described above, Hansen does not teach a "designer location". Hansen fails to anticipate claim 18 for at least that reason.

Applicant further notes that Hansen does not teach a designer location, or other location for that matter, configured to: "receive from a print service provider location real time configuration information regarding a print production device at the print service provider location", "generate packaging instructions that describe how the printed output is

to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information”, or “create a high performance file that contains the digital file and the packaging instructions” for reasons described above in relation to claim 1.

Furthermore, also for reasons described above, Hansen fails to teach a print service provider location configured to “package the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file”.


In view of the above, it is clear that Hansen does not anticipate claim 18 or claims 19-23 which depend therefrom. Applicant therefore respectfully requests that the rejections of claims 18-23 be reversed.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:



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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A method of performing automated packaging on a printed output in a commercial printing environment that includes a designer location and a print service provider location, said method comprising:

creating at the designer location a digital file that represents an image to be printed;

receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location;

generating at the designer location packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information;

creating at the designer location a high performance file that contains the digital file and the packaging instructions;

submitting the high performance file from the designer location to the print service provider location via an electronic network; and

generating at the print service provider location a printed output of the digital file and packaging the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file.

2. A method of performing automated packaging according to claim 1, further comprising verifying at the print service provider location that the digital file will be produced as indicated by the high performance file and, if not, correcting the high performance file, including the packaging instructions, to ensure production substantially as designed.

3. A method of performing automated packaging according to claim 2, wherein correcting the high performance file comprises reading the packaging instructions contained in the high performance file and preparing appropriate corresponding instructions for an actual packaging device to be used at the print service provider location.

4. A method of performing automated packaging according to claim 2, wherein correcting the high performance file comprises adding packaging instructions to the high performance file for an actual packaging device to be used at the print service provider location to supplement packaging instructions prepared at the designer location.

5. A method of performing automated packaging according to claim 2, further comprising sending an indication of the operational status of the packaging device to a server computer at the print service provider location.

6. A method of performing automated packaging according to claim 2, further comprising sending an indication of the job completion status of the packaging device to a server computer at the print service provider location.

7. A method of performing automated packaging according to claim 2, wherein correcting the high performance file further comprises updating a job ticket also contained within the high performance file.

8. A method of performing automated packaging according to claim 1, wherein generating packaging instructions comprises selecting an available packaging device based on the received configuration information.

9-17. (Canceled)

18. A system for performing automated packaging on a printed output, said system comprising:

a designer location configured to:

create a digital file that represents an image to be printed,

receive from a print service provider location real time configuration information regarding a print production device at the print service provider location,

generate packaging instructions that describe how the printed output is to be packaged for shipment after printing, the packaging instructions being generated relative to the received configuration information,

create a high performance file that contains the digital file and the packaging instructions, and

submit the high performance file to the print service provider location via an electronic network; and

a print service provider location configured to generate a printed output of the digital file and package the printed output at the print service provider location in accordance with the packaging instructions contained within the high performance file.

19. A system for performing automated packaging according to claim 18, wherein the print service provider location is further configured to verify that the digital file will be produced as indicated by the high performance file and, if not, correct the high performance file, including the packaging instructions, to ensure production substantially as designed.

20. A system for performing automated packaging according to claim 19, wherein the print service provider location is configured to correct the high performance file by reading the packaging instructions contained in the high performance file and preparing appropriate corresponding instructions for an actual packaging device to be used at the print service provider location.

21. A system for performing automated packaging according to claim 19, wherein the print service provider location is configured to correct the high performance file by adding packaging instructions to the high performance file for an actual packaging device to be used at the print service provider location to supplement packaging instructions prepared at the designer location.

22. A system for performing automated packaging according to claim 19, wherein the print service provider location is configured to correct the high performance file by updating a job ticket also contained within the high performance file.

23. A system for performing automated packaging according to claim 18, wherein the designer location is configured to generate packaging instructions by selecting an available packaging device based on the received configuration information.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.